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Thomas Salutzki

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EXAMINER

WILLIAMS, THOMAS J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/518,702
Filing Date: December 20, 2004
Appellant(s): SALUTZKI, THOMAS

Alfred W. Froebrich
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 26, 2008 appealing from the Office action mailed January 17, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,618,899	Ginzel et al.	9-2003
6,077,908	Yahiro	6-2000
4,019,220	Lieberman	4-1977

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 9, 10 and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,618,899 to Ginzel et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a

Art Unit: 3683

showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Re-claim 9, Ginzel et al. disclose an apparatus for opening and closing a door leaf, comprising: a housing made of a polyoxymethylene plastic (see column 7 lines 18-37), the housing has a recess; a piston 6 made of polyoxymethylene (see column 2 lines 62-66 and column 7 lines 18-37), the piston has a toothed rack 11; a closing shaft 3 comprises a pinion 12 that engages the rack 11 (see figure 4); a closing spring 13 is arranged in the recess and acts on the piston, Ginzel et al. incorporate by reference in its entirety US 4,019,220 which discloses a piston and rack apparatus, wherein the rack is made of metal and the piston is molded around the rack. The step of embedding the metal rack in the piston by molding the polyoxymethylene plastic around the rack to form a one piece element is considered by the examiner as a process step, and as such the claim becomes a product by process. However, the process step can not be relied upon for determining patentability in an apparatus claim, see MPEP 2113.

Re-claim 10, the piston and housing are formed by injection molding, see column 3 lines 33-37.

Re-claims 12 and 13, the housing is fitted with bearing shells 16, the bearings are made of polyoxymethylene plastic; the bearing shells are press fitted into the housing and welded using ultrasonic welding, see column 9 lines 11-18.

Art Unit: 3683

Re-claims 14-16, end plugs 18 and 19 are made of polyoxymethylene plastic and attached by ultrasonic welding; the openings at each end are broadly interpreted as hydraulic openings which are subsequently sealed with caps 18 and 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/36255 to Ginzl et al. in view of US 6,077,908 to Yahiro.

Re-claims 9, 10 and 12-16, Ginzl et al. teach an apparatus for opening and closing a door leaf, comprising: a housing made of plastic, the housing has a recess; a piston 6 made of plastic, the piston has a toothed rack 11; a closing shaft 3 comprises a pinion 12 that engages the rack 11 (see figure 4); a closing spring 13 is arranged in the recess and acts on the piston; the piston and housing are formed by injection molding (see abstract); Ginzl et al. incorporates by reference in its entirety US 4,019,220 which discloses a piston and rack apparatus, wherein the rack is made of metal and the piston is molded around the rack; the housing is fitted with bearing shells 16, the bearings are made of plastic; the bearing shells are press fitted into the housing and attached by ultrasonic welding (see page 7 line 5 of the translation); end plugs 18 and 19 are made of plastic and are attached by ultrasonic welding (see page 8 lines 9-10); the openings at each end are broadly interpreted as hydraulic openings which are subsequently sealed

Art Unit: 3683

with caps 18 and 19. The step of embedding the metal rack in the piston by molding the polyoxymethylene plastic around the rack to form a one piece element is considered by the examiner as a process step, and as such the claim becomes a product by process. However, the process step in a product-by-process claim can not be relied upon for determining patentability in an apparatus claim, see MPEP 2113

Ginzel et al. teach the type of plastic used is preferably glass fiber or carbon fiber reinforced, but fail to teach the specific type of plastic used as being a polyoxymethylene plastic.

Yahiro teaches a glass fiber reinforced polyoxymethylene plastic used for making a variety of products, such as brake pistons, caps, housings and other various structures, see column 8 lines 57-67 to column 9 lines 1-51. The polyoxymethylene plastic provides excellent heat stability and weatherability, and as such is useful for outdoor conditions, as would be experienced by a door closing mechanism. It would have been obvious to one of ordinary skill in the art to have manufactured the various parts of Ginzel et al. from a polyoxymethylene plastic as taught by Yahiro, thus providing a durable product resistant to heat and inclement weather.

(10) Response to Argument

As noted by the applicant the examiner interprets the recitation "[wherein the toothed rack is made of metal] and is embedded in the piston by molding the polyoxymethylene plastic around the rack so that the rack and the piston form a one-piece element" as a product-by-process recitation. As is clearly illustrated in both Ginzel et al. references the rack and piston form a one piece element, in that they are connected with

Art Unit: 3683

one another and are not easily separable. It is important to note that the rack must be fixedly attached to the piston in order to operate properly, otherwise the damping function of the device would fail. It is the opinion of the examiner that the final structure of a rack and piston forming a one piece element recited in the claim is taught by both Ginzel et al. references. As such the only significant difference between the instant invention and the prior art is the process by which the structure is achieved. In this case the process of molding the piston around the rack during the manufacturing operation. The molding process itself is not unique and is utilized extensively in the manufacturing arts, and is mentioned by Ginzel et al. '899 as a means of producing the plastic parts of the door closer, see column 6 lines 32-35. As such Ginzel et al. provides motivation for using an injection molding process. Therefore, it is the opinion of the examiner that any advantages achieved by molding the piston around the rack would have been known to one of ordinary skill in the art and would not have been unique in any way. Furthermore, as stated by the examiner in the Advisory mailed April 4, 2008 the disclosed invention fails to teach any unique or unexpected results achieved by the molding step, and yet the applicant relies upon this argument for patentability. It seems to the examiner that if an unexpected result is achieved by embedding the rack through a molding step within the piston then some sort discussion of this would appear in the disclosure. Since this is not the case the examiner can not give this process step full consideration in view of the art. It is noted that Lieberman, incorporated by reference by Ginzel et al., teaches a door closer apparatus with a metal rack in combination with a plastic piston.

Art Unit: 3683

The examiner relies upon Yahiro as remedying the deficiency of Ginzel et al. '255 with regards to the use of a polyoxymethylene plastic for the piston structure. Yahiro teaches that this type of plastic is particularly suitable for outdoor use and has good durability, two features that are desirable with a door closing mechanism, since the door closing mechanism may see repeated use and might be exposed to the elements. As such it is the opinion of the examiner that the combination of Ginzel et al. and Yahiro is proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Thomas J. Williams

/Thomas J. Williams/

Primary Examiner, Art Unit 3683

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Application/Control Number: 10/518,702

Page 9

Art Unit: 3683